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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

London Regional Transport
v.
The William A. Berdan & Edward C. Goetz, III Partnership and
InterShoe, Inc., joined as party defendant.¹

Opposition No. 91106031

Vincent N. Palladino of Fish & Neave IP Group of Ropes & Gray LLP
for London Regional Transport.

Jeffrey D. Goldman of Mitchell, Silberberg & Knupp LLP for The
William A. Berdan & Edward C. Goetz, III Partnership.

Before Quinn, Holtzman and Zervas, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by The William A. Berdan &
Edward C. Goetz, III Partnership (applicant or B&G) to register
the mark LONDON UNDERGROUND (in standard character form) on the
Principal Register for the following goods and services: "men's
and women's apparel, namely, shoes and other footwear, pants,

¹ Joined by Board order of February 22, 2001.

shirts, jackets, sweaters, shorts, dresses, skirts, coats, belts, hosiery, gloves and headwear" in International Class 25; and "retail clothing stores" in International Class 42. The application (Serial No. 75123951) was filed on June 24, 1996 based on an allegation of a bona fide intention to use the mark in commerce. Applicant has not filed an amendment to allege use.

On May 1, 1997, London Regional Transport (opposer), a public utility established by statute in the United Kingdom, filed an opposition to registration of the above application. As grounds for opposition, opposer alleged that long prior to the June 24, 1996 filing date of the application, opposer has been engaged in providing public transportation services in the United Kingdom under the mark LONDON UNDERGROUND, and offering for sale various products, including clothing, in connection therewith; that the mark as used on these goods and services has become famous and its reputation is known in the United States; and that applicant's mark for the goods and services identified in the application so resembles opposer's mark as to be likely to cause confusion, mistake or deception.

Applicant filed an answer denying the salient allegations of the notice of opposition. In addition, applicant, now identifying itself as Planet Luv-Tron, Inc. in the answer, alleges that there has been a series of assignments involving its application. In particular, applicant notes an assignment from

B&G to Planet Luv-Tron, Inc., ("PLT") (on May 28, 1998); a subsequent assignment from PLT to Intershoe, Inc., ("Intershoe") (on April 28, 1999); and an assignment from Intershoe back to PLT (on February 5, 2001).

Opposer, in response, filed an amended pleading alleging, in addition to its previously stated ground of likelihood of confusion, a claim that applicant and its successors have abandoned the mark for all goods and services. Opposer also alleged that pursuant to the April 28, 1999 assignment from PLT to Intershoe, PLT was not permitted to use LONDON UNDERGROUND as a mark for retail clothing stores anywhere in the United States other than an area in and around Portland, Oregon; that from April 28, 1999 through February 5, 2001, Intershoe did not use LONDON UNDERGROUND for retail clothing stores or exercise control over any retail clothing stores that may have been operated by PLT in and around Portland, Oregon during that time; that from April 28, 1999 through February 5, 2001, Intershoe did not use LONDON UNDERGROUND for "pants, shirts, jackets, sweaters, shorts, dresses, skirts, coats, belts, hosiery, gloves and headwear" or for any "footwear" other than "shoes"; that the shoes marketed by Intershoe under LONDON UNDERGROUND "differed from the shoes marketed by B&G [applicant] or PLT prior to April 28, 1999"; and that Intershoe discontinued use of LONDON UNDERGROUND for shoes prior to February 5, 2001.

Applicant filed an answer to the amended pleading denying the salient allegations therein.

The record consists of the pleadings; the file of the involved application; opposer's testimony, with exhibits,² of David Ellis, head of intellectual property rights development for opposer; applicant's testimony, with exhibits, of William Berdan, one of applicant's partners, and John Koo, president of T.I.S.S., Ltd. (successor to PLT); and notices of reliance by both parties.

Briefs have been filed, and an oral hearing was not requested.

Before turning to the merits of this case, there are several preliminary matters that require our attention. To begin with, we need to clarify the issues in this proceeding. As noted earlier, the application was filed on June 24, 1996 based on an intent to use the mark in commerce, and an amendment to allege use has not been filed. Applicant argues in its brief that it actually began using the mark through its predecessors in 1989, and applicant is claiming priority based on that use.³ Opposer

² The Board was unable to locate the original exhibits which included a number of books. Opposer provided the Board with copies of the missing exhibits including copies of pages from the books that opposer wished the Board to consider.

³ Although this claim of use earlier than the filing date was not pleaded as a defense, it was nonetheless tried by the parties. Therefore, the answer is deemed amended in accordance with Fed. R. Civ.

argues in its brief that nonuse of the mark by applicant's predecessors from 1993 to 1996 establishes, prima facie, that applicant abandoned the mark. In addition, opposer, in its amended pleading, alleged that applicant abandoned the mark as a result of the nonuse of the mark by applicant's successors.

Opposer appears to have framed the issue of abandonment as a separate ground for opposition and the parties have argued abandonment as a separate claim in their briefs. However, nonuse of a mark prior to the filing of a statement of use cannot be used to make out a prima facie case of abandonment in an intent-to-use application.⁴ Consolidated Cigar Corp. v. Rodriguez, 65 USPQ2d 1153 (TTAB 2002). There can be no issue of abandonment of the mark in this case apart from the issue of priority in the likelihood of confusion claim. Thus, the parties' evidence and arguments on abandonment are construed as relating solely to applicant's claim of priority and not as a separate ground for opposition.

As a further matter, we note that there have been a series of assignments affecting the involved application. In addition to the assignments noted by applicant in its answer to the

P. 15(b), to conform to the evidence by asserting use of the mark by applicant prior to the filing date of its intent-to-use application.

⁴ We note that opposer has neither pleaded nor argued that applicant did not have a bona fide intention to use the mark as of the filing date of the application, and to the extent, if any, that opposer is attempting to assert or argue this claim, it has not been proven.

opposition, the record shows that the application was further assigned, this time to T.I.S.S., Ltd., on April 12, 2002. With respect to all of the assignments, except the April 28, 1999 assignment from PLT to Intershoe, the issue as framed in opposer's amended pleading only concerns the alleged nonuse of the mark by applicant and its successors, not the validity of the assignments. As to the April 28, 1999 assignment from PLT to Intershoe, although opposer pleaded that Intershoe did not exercise control over use of LONDON UNDERGROUND for the retail clothing store services, opposer neither pursued this claim in its brief nor offered any proof at trial. Accordingly, that issue will be given no further consideration. In any event, we find as to all of the assignments, including the assignment from PLT to Intershoe, that applicant has shown, by appropriate testimony and supporting documents, an uninterrupted chain of title and continuity of control of these various entities to the mark commencing from the filing date of the application.⁵

We also note that applicant, in its brief, has attempted, in effect, to delete certain goods as well as the services from the application. In particular, applicant states:

⁵ The document evidencing the April 28, 1999 assignment from PLT to Intershoe indicates that PLT retained a right to own and operate retail stores selling the LONDON UNDERGROUND products within a 50-mile radius of Portland, Oregon, and was granted a non-exclusive license to use LONDON UNDERGROUND as the name of the store. The assignment further provides that the stores bearing the LONDON UNDERGROUND name will meet the standards of quality established by Intershoe.

In addition to shoes and other footwear, Applicant's application also lists the following goods and services: pants, shirts, jackets, sweaters, shorts, dresses, skirts, coats, belts, hosiery, gloves and headwear; and retail clothing stores. Applicant no longer seeks registration of LONDON UNDERGROUND in connection with those goods and services. (Brief, p. 1, footnote 1.)

Opposer, in its reply brief, maintains that the Board "should enter judgment sustaining the opposition in its entirety." Reply Brief, p. 1.

In view of applicant's statement that it no longer seeks registration for goods and services other than "shoes and other footwear," and since applicant did not argue prior use of the mark for any goods or services other than footwear in its brief, for purposes of the issue of priority, we construe applicant's statement as a concession that applicant did not use the mark on any goods or services other than footwear prior to the filing date of the application.⁶ However, to the extent that applicant seeks to delete those goods and services from the application, we point out that such an amendment to the application should have been raised by a motion, and further, as the amendment would affect the issues in this case, it should have made prior to trial in order to give opposer fair notice of the narrower goods. See Trademark Rule 2.133(a); and TBMP §514.03 (2d ed. rev. 2004).

⁶ In this regard, we also note applicant's statement on page 12 of its brief that "Applicant uses its LONDON UNDERGROUND mark in commerce only in connection with shoes and other footwear."

An unconsented motion to amend which is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties. See §514.03, *supra*. Thus, we will address the amendment later in this decision when we reach the substantive issues in the case.

We turn now to the merits of this case and the issue of priority. Briefly stated, opposer contends that it first used the mark LONDON UNDERGROUND in the United States in 1992, prior to the June 24, 1996 filing date of the application, and that, in any event, opposer has priority under the "famous mark exception" to the requirement for use in commerce. Applicant, for its part, contends that it first used the mark LONDON UNDERGROUND at least since 1989, prior to opposer's first use, and moreover that the "famous mark exception" does not apply in this case. Opposer disputes applicant's claim of prior use, contending that applicant abandoned the mark on footwear for failure to use the mark on footwear for the three-year period from 1993 to 1996.

**APPLICANT'S CLAIM OF USE EARLIER THAN THE APPLICATION
FILING DATE**

We turn first to applicant's claim of use of the mark on footwear earlier than its filing date and prior to opposer's claimed date of first use in 1992. The record shows that prior to filing the application, William Berdan was involved in

numerous companies that allegedly had, at one time or another, sold footwear under marks other than LONDON UNDERGROUND or had operated retail stores under various names, some of which incorporated the name LONDON UNDERGROUND. The testimony as to the nature of these different entities and the time frames during which they operated is often vague and confusing. We have considered the various incarnations of these companies only insofar as we can determine that they are relevant to the use of the mark LONDON UNDERGROUND in connection with footwear.

Mr. Berdan testified that prior to 1988 he operated a retail shoe store as a sole proprietorship under the name Footsteps, and "somewhere around '86, '87, maybe '88" changed the name of the store to London Underground. (Test., p. 13-14.) It is not clear whether the business remained a sole proprietorship at the time the name of the store was changed.⁷ Then, according to Mr. Berdan, in 1988 or 1989, Mr. Berdan, "in partnership with" Ed Goetz and Norcrest China, started a wholesale footwear business, with Mr. Berdan and Mr. Goetz each owning 25% of the business and Norcrest China owning 50%. (Test., p. 16.) Mr. Berdan states that this company sold DOC MARTENS footwear and footwear under the mark LONDON UNDERGROUND "starting in 1989." (Test., p. 25.)

⁷ When Mr. Berdan was asked if the type of business remained a sole proprietorship when the name of the store was changed to London Underground, he responded, "Well it switched to an LLC somewhere in the early 90s." (Test., p. 16.)

Mr. Berdan explains that "in '91 or '92" when this business began to grow, the name of the company was changed to London Underground International Limited Partnership, with Berdan and Goetz as limited partners and Norcrest China as the general partner. (Test., pp. 17, 25.) Then in 1994, the partnership formed a new company, "Air Wear U.S.A.," comprised of Air Wear (a factory in England), "Dr. Martens," Norcrest China and Ed Goetz. According to Mr. Berdan, that company was formed to import and sell at wholesale DOC MARTENS brand footwear in the United States. Mr. Berdan states that the company lasted, by agreement, for two years, from 1994 to 1996. Mr. Berdan does not state that the LONDON UNDERGROUND mark was used on footwear during that time period. In 1996, Mr. Berdan and Mr. Goetz formed a company called London Underground, Inc., to sell at wholesale LONDON UNDERGROUND shoes. Mr. Berdan explains that B&G, the same entity that applied for registration, owned London Underground, Inc. at that time.

An applicant is entitled to rely on actual trademark use or use analogous to trademark use earlier than the filing date of its intent-to-use application. See *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477 (TTAB 1998); and *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251 (TTAB 1995). In a use-based application, the applicant, when attempting to prove a date of first use earlier than that set

forth in its application, is required to prove such use, not by a preponderance of the evidence, but by the stricter clear and convincing evidence standard. See *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987). However, under either standard of proof, applicant's evidence is insufficient to establish either actual use or analogous use prior to the filing date of its application.

Mr. Berdan's broad conclusory statement that applicant's predecessor sold shoes under the LONDON UNDERGROUND mark "starting in 1989," unsupported by any underlying facts or documentary proof, is insufficient evidence of use during that time. Applicant has offered no details or information regarding any sale, offer for sale, or preparation for sale that might have taken place between 1989 and 1994. We also note that there is no testimony, nor does applicant even argue, that LONDON UNDERGROUND brand shoes were ever sold in Mr. Berdan's London Underground store. Further, applicant has admitted that it made no use of LONDON UNDERGROUND on footwear between 1994 and 1996.⁸

Moreover, applicant has not shown how it is entitled to tack on earlier use of the mark by third parties such as London Underground International Limited Partnership and Air Wear U.S.A.

⁸ Applicant states in its response to opposer's interrogatory no. 1(c) that applicant did not use the mark "between approximately 1993 and 1996." Mr. Berdan subsequently testified to the effect that the mark was not used between 1994 and 1996.

Applicant never explains the relationship of these earlier entities to the present partnership, nor has applicant established a chain of title to the mark or continuity of control over use of the mark from one company to the next.⁹

Thus, we find the evidence far from sufficient to establish, under either standard of proof, that applicant used LONDON UNDERGROUND on footwear prior to the June 24, 1996 filing date of the application. Accordingly, the filing date of its application is the earliest date on which applicant is entitled to rely for purposes of priority.¹⁰

**DISTINCTIVENESS OF OPPOSER'S MARK
AND OPPOSER'S CLAIM OF PRIORITY**

In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of an unregistered mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). The facts bearing on these issues are found to be as follows.

Opposer, London Regional Transport, is a public utility that was established under a government act in the United Kingdom in

⁹ To the extent, if any, that Mr. Berdan's testimony regarding use could be considered sufficient to show a bona fide intent to use the mark earlier than the filing date, this claim would be defeated by applicant's failure to show any continuing effort to associate the mark with applicant and its goods. See *Dyneer Corp. v. Automotive Products plc*, *supra*.

¹⁰ Under the circumstances, any issue as to applicant's abandonment of the mark for nonuse between 1993 and 1996 is moot.

1984, and it was succeeded in 2000 by the transport authority, Transport for London. Mr. David Ellis, who, as noted above, testified at trial, is the head of intellectual property rights development for Transport for London. He is employed by the London Transport Museum, a "wholly owned company" of Transport for London, through Transport Trading Limited, which is the commercial arm of Transport For London. (Test., p. 43.) Mr. Ellis has been employed by the company for "about 14 years" and he reports to the director of marketing for Transport for London.

Mr. Ellis testified that Transport for London is the transport authority for the greater London area, controlling the rivers, main road arteries, buses, the London Underground railway, and essentially the entire public transport system in London. According to Mr. Ellis, opposer's railway system has been in existence for nearly 150 years, and it was the world's first underground system. When the railway first opened in 1863 it was known as the Metropolitan Railway Company. Mr. Ellis states that opposer has been using the LONDON UNDERGROUND mark in connection with the railway system since at least as early as 1901.

Mr. Ellis estimates that between 25 and 30 million people visit London each year. This estimate is apparently based on a chart prepared by the London Tourist Board which shows the total

number of visitors to London for each year from 1950 to 2002.¹¹

Mr. Ellis contends that 20% of visitors to London are from the United States and that 92% of tourists in London ride the London Underground, stating that it is the "easiest" and "the most famous" way to get around the city. (Test., p. 13.)

Pointing to a document containing a list of opposer's overseas sales agents, Mr. Ellis states that visitors can obtain information about the London Underground and purchase tickets, maps and guides for the railway before they arrive in London through its network of agents around the world. The document lists three sales agents in the United States, located in White Plains, New York; Des Plaines, Illinois; and Bothell, Washington. Mr. Ellis states that opposer sells LONDON UNDERGROUND merchandise through the museum shop associated with the London Transport Museum. The museum opened in the mid-1960s, and since 1984 has been located in the central London district of Covent Garden, which Mr. Ellis describes as "the major tourist attraction in London." (Test., p. 15.) Mr. Ellis contends that the museum has had about 220,000 visitors a year since its major redevelopment in 1994 and prior to that, from 1984-1994, about 130,000 to 160,000 visitors a year. He states that the museum shop sells typical museum products under the LONDON UNDERGROUND

¹¹ Opposer explains that the London Tourist Board is the government body responsible for developing tourism in London and that the chart is comprised of "government-based statistics." (Test., p. 12.)

mark, including t-shirts, pins, playing cards, umbrellas, handbags, traveling bags and credit card-shaped flashlights, and he has introduced examples of such items displaying the LONDON UNDERGROUND mark. In addition to these products, the museum shop sells "London Underground Map" jigsaw puzzles and a LONDON UNDERGROUND "Computer Font Set," which includes a "London Underground" typeface font, as well as photographs and poster art featuring the London Underground system.

Opposer also sells LONDON UNDERGROUND merchandise through its mail order business which, according to Mr. Ellis, ships products "around the world." (Test., p. 18.) Mr. Ellis states, in particular, that its LONDON UNDERGROUND canvas bag "has been shipped into accounts in the U.S." (Test., p. 24.) LONDON UNDERGROUND products are also sold through opposer's licensees in duty free shops which are located around the city and in Heathrow Airport; through its licensee's major accounts such as Harrods department store and gift souvenir outlets; and through seven "travel information centers" such as Piccadilly Circus and Oxford Circus, located in and around London for the convenience of tourists, as well as in Heathrow and Gatwick airports.

Mr. Ellis also testified that opposer has sold LONDON UNDERGROUND products through companies located in the United States. He states that opposer sells its "Computer Font Set" through the website of a U.S. licensee, P22 Type Foundry. He

further testified that opposer "has had a very long relationship" with Rivertown Trading, a company located in St. Paul, Minnesota, and that opposer "started products" bearing the LONDON UNDERGROUND mark in 1992 in two of that company's mail order catalogues called *Signals* and *Wireless*. (Test., p. 28.) The merchandise, according to Mr. Ellis, consisted of such items as mugs, t-shirts and "sweats" and opposer's "famous" posters. (Test., p. 28.)

According to Mr. Ellis, opposer has been marketing the railway for about 90 years. He states that the railway was first advertised in 1908 on posters and on "poster sites" and that in recent times opposer has used the full range of media, including television, poster sites, radio, and newspapers, to advertise the system. Mr. Ellis states that advertising expenditures have grown from 400,000 pounds in the mid 1980s to 5 million pounds (\$7 million, Brief, p. 5.) in 2005. In addition, Mr. Ellis states that opposer gives away around six million schematic maps a year showing services, times and stations, and that the first maps were produced by opposer in 1933. Mr. Ellis does not indicate whether the LONDON UNDERGROUND mark appears on these maps.

Mr. Ellis notes that LONDON UNDERGROUND railway has been mentioned in newspapers published in the United States at least as early as 1948. He obtained archival copies of the relevant

pages of nine newspapers which represent, according to Mr. Ellis, a "very small selection" of the total articles. (Test., p. 32.) Two of the articles appeared in *The Frederick Post* (Frederick, Maryland) dated April 24, 2001 and August 28, 1993; two appeared in *Daily Herald* (unknown location) dated December 16, 1993 and November 11, 1988; and he introduced one article each from *The Intelligence Record* (unknown location) dated November 11, 1988; *Chronicle-Telegram* (Elyria, Ohio) dated March 4, 1985; *The Holland, Michigan, Evening Sentinel* dated May 24, 1966; *Sheboygan Press* (Wisconsin) dated May 4, 1966; and *Council Bluffs (Iowa) Nonpareil* dated November 19, 1948. The articles are about particular incidents that occurred on the railway during the relevant time periods.

In addition, according to Mr. Ellis, the London Underground has been the subject of "many hundreds" of books over the years. (Test., p. 7.) Mr. Ellis states that opposer itself has been publishing books for about a hundred years covering the transport operations, architecture, art, graphic design and the trademark, and that other companies have been publishing books about the London Underground for about 60 or 70 years. Mr. Ellis notes that one of opposer's publications about transport operations, London Underground Rolling Stock, is in its 15th edition, and he states that the book is sold in Europe, Japan "and North America." (Test., p. 8.) Another publication entitled The

London Underground/A Diagrammatic History, published in 1980, as described by Mr. Ellis, is a booklet about the history of the development of the London Underground system and all of the stations. The booklet includes an insert which folds out into a poster-size schematic map diagramming the development of the railway. Mr. Ellis states that the booklet is sold in bookshops in the United Kingdom and through its museum shop and mail order business.

Mr. Ellis testified that opposer has "a world famous London Underground poster collection" (Test., p. 36); that opposer has been commissioning poster art since 1908; and that this poster art has been the subject of many publications. The publications featuring the "London Underground" posters are entitled Icons of Design! The 20th Century (publication date unknown); Modernism (published in 1996); Art Deco Graphics (published in 1986); and A History of Graphic Design (published in 1983). Mr. Ellis claims that these books establish opposer's "international reputation for poster art." He points, in particular, to A History of Graphic Design which, according to Mr. Ellis, describes the importance of the posters and the famous artists that have been commissioned by opposer to do them, and he identifies Man Ray and Hockney as two such artists. As further support for his contention, Mr. Ellis quotes from Art Deco Graphics: "In Great Britain London Underground and the British Railroad published the

most important posters, with three non-British designers producing the most brilliant works: Marfurt, the Swiss artist living in Belgium; Alexander Alexieff, the Russian living in Paris; and the most important, McKnight-Kauffer, the American who led poster design in England for decades." (Test., p. 38.)

Finally, Mr. Ellis asserts that "the London Underground" has been "a back drop" to "hundreds of films" and that "many many many" of those films have been released in the United States. (Test., p. 38.) Mr. Ellis identified "Patriot Games" and "Sliding Doors" as two of the films that have been released in the United States.

Distinctiveness of Opposer's Mark

Opposer is asserting prior rights based on use of the word mark LONDON UNDERGROUND in typed form, without any design or form of stylization. Applicant argues that opposer uses a composite mark consisting of a word and a design described by applicant as a "roundel" and that the "roundel" design dominates its composite marks and appears in every version of opposer's mark.¹² Applicant contends that the omission of the words "London Underground" from what applicant claims is the majority of uses of opposer's mark

¹² The "roundel" design referred to by applicant and as shown in opposer's exhibits is a circle with a crossbar, and the design appears in the various exhibits with or without wording in the crossbar. An example of the "roundel" design as it appears without wording is shown below.



"essentially confesses" the lack of importance of the word portion of the mark. (Brief, p. 11.) Applicant further contends that where the wording does appear without the roundel, it is never used in a trademark sense or as an indicator of source. Moreover, according to applicant, opposer's placement of LONDON UNDERGROUND on its map of the subway system does not function as a trademark to identify the source of those goods, but instead is used in a generic sense to indicate that the map is of the London subway system.

The record shows that opposer's mark LONDON UNDERGROUND is used in a variety of formats in connection with its railway services and collateral products. In some instances the wording appears alone and in others it is used with, or as part of, the "roundel" design. Regardless of the format, however, the wording "LONDON UNDERGROUND" in each usage creates a separate commercial impression apart from the design matter in the mark. Further, the wording is always displayed in relatively plain block lettering which is essentially the equivalent, in its commercial impression, of a typed version of the mark.

Applicant's argument that LONDON UNDERGROUND is either not used as a trademark or is used as a generic term is unavailing. First, to the extent applicant is asserting that the mark is generic or otherwise lacks distinctiveness, such claim was neither pleaded as a defense by applicant nor tried by the

parties.¹³ Thus, to the extent applicant is making such arguments in its brief, they are untimely. See *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991) (finding applicant's contention, raised for first time in its brief, that opposer's mark THE CHICAGO CORPORATION is geographically descriptive and that opposer therefore lacks proprietary rights in the mark untimely). Moreover, technical trademark use is not necessary for a showing of priority. See *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 11 USPQ2d 1638 (Fed. Cir. 1989); and *Ford Motor Co. v. Ford*, 462 F.2d 1405, 174 USPQ 456 (CCPA 1972). In any event, LONDON UNDERGROUND is clearly used, at least as it appears on the poster-size schematic map diagramming the history of the stations, as a mark in connection with the rendering of opposer's railway services.

Priority Based on Use in the United States

Opposer claims that it has priority based on actual use of the mark in the United States since 1992 or at least since the filing date of the subject application. However, the record simply fails to support that claim.

¹³ Nor are there any other circumstances in the case which would have put opposer on notice of this defense. See, e.g., *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993) (finding that opposer's opposition to applicant's mark "BODY GEAR" for clothing on ground of descriptiveness raised an issue as to whether "BODY GEAR" in opposer's mark is merely descriptive as applied to opposer's clothing and thus as to opposer's proprietary rights in the term for purposes of its likelihood of confusion claim).

Actual trademark use on goods requires a bona fide sale or transportation of the goods in commerce. See Section 45 of the Trademark Act. Mr. Ellis testified that opposer sells the LONDON UNDERGROUND "Computer Font Set" through the website of P22 Type Foundry, a United States-based company, but he has offered no information as to what date the first sale took place or, for that matter, whether any customer in the United States ever purchased the product or visited the website. Mr. Ellis also testified that opposer has had "a long relationship" with Rivertown Trading located in St. Paul, Minnesota. However, opposer never describes this relationship, and it is not clear from the testimony that any LONDON UNDERGROUND goods were actually sold through that company's *Signals* and *Wireless* catalogues, or that such goods were sold prior to the filing date of the application. The extent of Mr. Ellis' testimony on this subject is as follows (p. 28):

- Q. ...Do you know whether any London Underground products have been sold by anyone located in the United States through customers in the United States?
- A. Yes, ... we've had a very long relationship with a company called Rivertown Trading who operate to [sic] mail order, very widely [sic] mail order catalogues called *Signals* and *Wireless*.
- Q. How long has your relationship with --
- A. We go back, I first contacted them in the U.K. in about '91 and we started products in '92.

Q. When you say you started products, what do you mean?

A. Well they started entering their catalog in 1992.

Q. And what, if any, London Underground products do they make available?

A. Oh, yes, we had quite a variety. We had I think like mugs, of course T-shirts and sweats and our famous posters as well.

Nor is this evidence sufficient to show use analogous to trademark use, which requires a showing of an open and public use of such nature and extent as to create, in the mind of the relevant purchasing public, an association of the designation with the plaintiff's goods. See *Otto Roth & Co.*, supra; and *Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673 (CCPA 1972). See also *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). While Mr. Ellis' testimony suggests that clothing and posters did appear in the catalogues, it is unclear when these items first appeared and, in particular, whether they appeared prior to the June 24, 1996 filing date of the application. Even if we assume that LONDON UNDERGROUND products did appear in the catalogues prior to the filing date of the application, we have no testimony as to the extent of distribution of the catalogues or how many consumers they may have reached such that we could infer that the use was sufficient to create a public identification of LONDON

UNDERGROUND with opposer's goods. See, e.g., T.A.B. Systems v. PacTel Teletrac, supra at 1882 (brochures and news articles were not shown to have been so broadly or repetitively distributed that one could reasonably infer that the consuming public came to identify TELETRAC with PacTel's services).

Just as applicant's general and unsupported statements about its use were not sufficient to prove use of its mark on footwear prior to the filing date of its application, opposer's general and unsupported statements are not sufficient to demonstrate its priority of use of LONDON UNDERGROUND for clothing and posters.

Priority Based on the Famous Mark Exception

We turn next to opposer's claim of priority based on the famous mark exception. Opposer argues that its LONDON UNDERGROUND mark is "among the most well known marks in the world." (Brief at 3.) Applicant, however, maintains that opposer has failed to carry its burden of showing that LONDON UNDERGROUND qualifies for the famous mark exception. Applicant argues that the only evidence of fame introduced by opposer, i.e., the number of American tourists visiting London, the percentage of those tourists that use London's subway system, and the fact that the subway system appears in American movies, is irrelevant to the Board's analysis. It is applicant's contention that opposer has failed to introduce any evidence, "that any person in the United States, much less any substantial percentage

of the American public, is familiar with opposer's foreign trademark." (Brief, p. 18.)

As we noted earlier, in order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of an unregistered mark, the plaintiff is required to show priority of use. "Use" means use of the mark in United States commerce.

Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990). It is well settled that under the "territoriality" principle of trademark law, prior use of a mark in a foreign country does not create priority rights in the United States.¹⁴ See Person's Co. v. Christman, supra; Empresa Cubana del Tabaco v. Culbro Corp., 399 F.3d 462, 73 USPQ2d 1936

¹⁴ As noted earlier, a party can establish priority based upon advertising or other analogous use. However, it is well established that prior use and advertising of a mark in connection with goods or services marketed in a foreign country, whether the advertising occurs inside or outside the United States, creates no priority right in said mark in the United States as against one who, in good faith, adopted the same or similar mark for the same or similar goods or services in the United States. See Mothers Restaurants, Inc. v. Mother's Other Kitchen, Inc. 218 USPQ 1046 (TTAB 1983). See also First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc., 77 USPQ2d 1334 (TTAB 2005); and Techex, Ltd. v. Dvorkovitz, 220 USPQ 81 (TTAB 1983). As to the question of good faith adoption, opposer argues that "the record fails to establish applicant's innocent adoption of LONDON UNDERGROUND for footwear." (Brief, p. 12.) However, the burden is on opposer to prove that applicant adopted the mark in bad faith, not on applicant to prove its good faith. Furthermore, applicant has offered a plausible "good faith" explanation for its adoption of the mark. Mr. Berdan testified that he and Mr. Goetz made the decision "in the late 80s" to adopt and use the LONDON UNDERGROUND mark "[b]ecause we wanted to be associated with London, and we wanted to be associated with the underground movement that was going on, the grunge kind of movement." (Test., p. 24.) Mr. Berdan also testified that the name of the retail store was changed to reflect the style of shoes they wanted to sell, "more punk rock oriented and grunge-type shoes" which were popular at the time. (Test., p. 14.)

(2d Cir. 2005); Grupo Gigante SA de CV v. Dallo & Co., 391 F.3d 1088, 73 USPQ2d 1258 (9th Cir. 2004); and British-American Tobacco Co. v. Philip Morris Inc., 55 USPQ2d 1585 (TTAB 2000).

An exception to this principle is the "famous mark" doctrine.¹⁵ Under this doctrine, a foreign party is entitled to priority if it can show that its mark was, at the time of the adoption and first use of a similar mark by the first user in the United States, a "famous" mark among relevant purchasers in the United States. *Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, supra, citing *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 123 USPQ 357 (N.Y. Sup.Ct. 1959). See also *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, supra; and *Techex, Ltd. v. Dvorkovitz*, supra.

The question for us to decide is whether the mark is of sufficient renown to qualify for protection under the famous mark doctrine.¹⁶ See, e.g., *Grupo Gigante*, supra; *ITC Ltd. v. Punchgini Inc.*, 373 F.Supp 2d 275, 74 USPQ2d 1239 (S.D.N.Y. 2005); and J. Thomas McCarthy, *Trademarks and Unfair Competition* §29:4 (4th ed. 2006). Although the existence of this doctrine has

¹⁵ Another exception to the territoriality principle, as noted in *Person's*, supra, is Section 44 of the Trademark Act which allows a foreign applicant to obtain a registration in the United States without ever having used the mark in United States commerce.

¹⁶ The question of "fame" for purposes of priority concerns whether the mark is entitled to any protection at all and so must be distinguished from the determination of fame in the context of a likelihood of confusion analysis where fame is a relative concept and concerns the extent of protection to which the mark is entitled.

been acknowledged in decisions by the Board and federal courts, the doctrine has seldom been invoked and there is little developed case law in this area.

The Board's first and, until now, only application of the doctrine was in *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*, 220 USPQ 1069 (TTAB 1983). In that case, the Board concluded that WIMBLEDON for annual tennis championships held exclusively in a foreign country was entitled to protection in the United States, finding that the tennis championships had received widespread coverage in magazines circulating in the United States, that the championships had been televised in the United States for over 20 years, and that the championships "enjoy considerable fame and notoriety in the United States." The Board did not enunciate a specific standard to determine the level of recognition required to show fame for purposes of the famous mark exception, concluding only that the mark "has acquired fame and notoriety ... within the meaning of *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 123 USPQ 357 (N.Y. Sup.Ct. 1959)." (*Id.* at 1072.) Thus, we turn to a consideration of *Vaudable* for a fuller explication of the standard necessary to show fame.

In *Vaudable*, the court granted an injunction sought by MAXIM'S restaurant in Paris against defendants' use of the name

MAXIM'S for a restaurant in New York, finding the name "famous in the high-class restaurant field." The Court stated:

[MAXIM'S] received wide publicity as the setting of a substantial portion of Lehar's operetta, 'The Merry Widow,' has been the subject over a long period of years of numerous newspaper and magazine articles, and has been mentioned by name and filmed in movies and television. There is no doubt as to its unique and eminent position as a restaurant of international fame and prestige. It is, of course, well known in this country, particularly to the class of people residing in the cosmopolitan city of New York who dine out. (*Id.* at 358.)

It is not entirely clear from the decision, but it appears that the Court applied the standard of secondary meaning in making its determination that the mark was famous. In addressing defendants' arguments concerning the actual source of the name "Maxim" as the name of a smokeless powder and machine gun, the Court concluded that "[w]hatever the source of the name, it is the origination and development of its use in a particular field which may entitle the user thereof to protection by virtue of the secondary meaning acquired therein." (*Id.* at 358.)

There have been only three other reported cases since *Vaudable* that have dealt with this issue on the merits,¹⁷ Grupo

¹⁷ In another recent case, *International Bancorp LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 66 USPQ2d 1705 (4th Cir. 2003), where the foreign company advertised its mark CASINO DE MONTE CARLO in the United States but only rendered its casino services in a foreign country, the question was framed in terms of whether the services were rendered in commerce, and in particular foreign commerce, not whether the mark was protectable under the famous mark exception to the requirement for use. Any question of whether opposer's use in the present case constitutes use in "foreign commerce"

Gigante S.A. de C.V. v. Dallo & Co., *supra*; ITC Ltd. v. Punchgini Inc., *supra*; and Empresa Cubana del Tacaba v. Culbro Corp., 70 USPQ2d 1650 (S.D.N.Y. 2004) *rev'd on other grounds*, 399 F.3d 462, 73 USPQ2d 1936 (2d Cir. 2005).¹⁸ In each case, the court has grappled with the question of the level of recognition required for fame to trigger the exception. The Ninth Circuit, the only federal appellate court to address this question, concluded that more than a showing of secondary meaning was required.¹⁹ The majority stated:

"To determine whether the famous-mark exception to the territoriality rule applies, the district court must determine whether the mark satisfies ...[not only the secondary meaning test], but by a preponderance of the evidence, that a *substantial percentage* of consumers in

has neither been tried nor argued by the parties. The District Court in *Almacenes Exito S.A. v. El Gallo Meat Market, Inc.*, 381 F. Supp. 2d 324, ___ USPQ2d ___ (S.D.N.Y. 2005), while stating that the doctrine may support a state cause of action, expressly rejected the doctrine as part of federal law.

¹⁸ In *Empresa*, the District Court found that the mark COHIBA for Cuban cigars was famous under the famous mark doctrine. The Second Circuit, in reversing the District Court's finding of infringement, found it unnecessary to reach the question of whether the famous mark doctrine exists or applies because the Cuban embargo prevented the plaintiff from acquiring any rights in COHIBA through the doctrine. In another case, *Buti v. Perosa, S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2d Cir. 1998), which involved the issue of "use in commerce," the Court acknowledged the famous mark doctrine in a footnote but pointed out that no claim based on the doctrine had been made in the case and that, in any event, the record would not support it.

¹⁹ In explaining why secondary meaning is not the appropriate test, the Court stated that treating international use differently from domestic use "is what the territoriality principle does" and that requiring only a showing of secondary meaning would "effectively eliminate the territoriality principle by eliminating any effect of international borders on protectability." (*Id.* at 1264).

the relevant American market is familiar with the foreign mark."²⁰ (emphasis in original).

Grupo Gigante, supra at 1264. The majority did not define what it meant by "substantial percentage" but Judge Graber, in a concurring opinion, while noting that the test does not require the level of fame necessary for dilution, stated she would require a showing that "a majority" of the relevant market is familiar with the foreign mark. See also McCarthy, supra at §29:4 (agreeing that "at least 50% of the relevant group is an appropriate measure of 'substantial' in this context.")

Recognizing that this is a stringent standard, Judge Graber explains that a heightened standard is necessary

...when conferring trademark protection to a mark that has never been, and perhaps never may be, used in this country. A conclusion that Plaintiffs' mark is well-known in the relevant sector brings with it the right to oust Defendants from their own market, notwithstanding the fact that they have established priority of use.

Grupo Gigante, supra at 1272.

We find that regardless of which test is applied, either the *Vaudable* test or the *Grupo Gigante* test, based on this record, opposer does not meet it. Opposer has presented essentially no probative evidence which shows, or from which we could infer, a

²⁰ The court goes on to state that "[t]he relevant American market is the geographic area where the defendant uses the alleged infringing mark." In Board cases, where geographic limitations are not in issue, the relevant market must be defined in terms of the purchasers and potential purchasers for the goods and services throughout the United States, without regard to geographic scope of the use.

wide exposure and recognition of the mark LONDON UNDERGROUND such that we could conclude that LONDON UNDERGROUND is famous among the relevant purchasers in the United States, the relevant purchasers for both opposer's and applicant's goods and services in this case consisting of the general public.

Opposer relies heavily on the alleged exposure of the mark to American visitors in London. There is reasonable support for Mr. Ellis' statement that 92% of tourists use the city's rail system for transportation. However, Mr. Ellis has made no effort to explain the basis for his claim that 20% of the tourists who visit London are from the United States. Further, opposer has failed to indicate the number of Americans that the 20% figure purportedly represents. Thus, even if we accept that percentage as accurate, we would have to extrapolate from the figures presented in opposer's chart based on the percentages supplied by opposer to determine the number of American tourists who visited London for each year from 1950 to 1996, and then extrapolate further to determine the number of American tourists who used the railway for each year.

Even if we perform the necessary calculations, ultimately finding that approximately 70 million United States visitors to London used the rail system between 1950 and 1996, the result is not significant. First, while this may constitute evidence that

70 million Americans have purchased opposer's railway services,²¹ opposer has provided no evidence of the circumstances under which these purchasers would encounter the mark LONDON UNDERGROUND in connection with the services. There is no testimony or other evidence that the LONDON UNDERGROUND mark is displayed at the station entrances or on the trains or anywhere else in or around the stations. It may be that the only mark purchasers would encounter at the railway is, for example, the "roundel" design with the word UNDERGROUND in the crossbar, the way it appears in several of opposer's exhibits such as the jigsaw puzzle of the London Underground map (Exh. 12), or the railway map depicted on the back of the playing cards (Exh. 9) or on one side of the flashlight (Exh. 7). The poster-size map contained in the booklet The London Underground/A Diagrammatic History, and which shows LONDON UNDERGROUND on the map, depicts the development and history of the London Underground system. Mr. Ellis never states or even suggests that this historical map is representative of the maps viewed by or distributed to the public. In fact, it is

²¹ We point out that applicant's reliance on *Linville v. Rivard*, 26 USPQ2d 1508 (TTAB 1993) and *Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, *supra*, to support its contention that this evidence is not relevant is misplaced. The question in both of those cases was whether the activities were sufficient to constitute "use in commerce" and *Linville*, in particular, concerned the question of use sufficient to obtain or maintain a registration, an issue which is distinct from the nature of use for purposes of establishing priority. Neither of those cases involved a determination of whether the mark fell within the famous mark doctrine, which is an exception to the requirement for use.

unclear whether the mark LONDON UNDERGROUND appears on any map, or for that matter any guide or ticket, actually distributed or issued to the public. During the testimony of Mr. Ellis, he never introduced any map which he stated was distributed to the public. The only testimony on this subject is as follows:

Q. ...Do you make available to the public any maps or other material that --

A. Oh, yes, on top of that we give away around 6 million maps a year.

Q. When you say six million maps a year, what does the map show?

A. The map is your London Underground map, so it shows your services, your times, your stations and information.

Further, there is no way to determine how many or what percentage of those 70 million Americans over a forty-six year period are first-time visitors or returning visitors to London such that we could determine how many different people would have been exposed to the mark, assuming the mark would be encountered at all. In any event, that figure represents, at best, less than 25% of the United States population and this number is not sufficient, in itself, to prove that the mark is famous to a substantial percentage of the American public. Moreover, that number does not reveal anything about these consumers' perception or awareness of the mark. While it is safe to assume that many travelers to London use the rail system for ease and convenience

in getting around the city, there is no evidence that any American has used the railway because it is, as Mr. Ellis claims, "the most famous way to get around the city."

Opposer's remaining evidence is equally unrevealing. There is no evidence of what percentage or number of American tourists visit the London Underground Museum, or that the museum is a "must see" destination for American tourists. In fact, in comparing the number of United States visitors to London with the number of visitors to the museum, the results suggest that the museum is not a priority destination. There is also no evidence of any sales of LONDON UNDERGROUND merchandise to American consumers, whether through the museum shop or other outlets, let alone any evidence of the quantity of any such sales. Nor is there evidence of the amount of sales generated by opposer's ticket offices located in the United States or how long the offices have been operating at those locations. Similarly, opposer has offered no evidence regarding the extent of sales or any sales of "Computer Font Sets" over the website of opposer's licensee or how long the website has been in existence.

While opposer's current advertising expenditures may be substantial, there is no mention of how much of that total, if any, has been expended in advertising directed to American consumers or if any such advertising reached consumers in the United States. And, certainly, for us to assume that this

advertising had any impact on United States travelers during their visits to London would be purely speculative.

Regarding opposer's poster art featuring the railway, Mr. Ellis has not established by his testimony that the artwork is internationally famous. Even if we could accept the information contained in the history, art and design books, on which opposer relies, as established fact, which we do not, Mr. Ellis has pointed to nothing in these books that states or from which we could infer that the posters are well known to consumers in the United States. Furthermore, we cannot infer merely from the existence of these books and the fact that they are available to the public, that any Americans, let alone large numbers of Americans, have been exposed to them during their visits to London. While opposer states that at least one of the books has been sold in "North America," there is no evidence of the extent of its circulation or sales in the United States or of any purchase of the books by American consumers.

Even if we assume that the artists commissioned to create the posters are well known to the American public, there is no information as to whether or to what extent the public is familiar with works of art featuring the London Underground railway. In point of fact, we do not see where the mark LONDON UNDERGROUND even appears in any poster depicted in the books. For example, the poster shown in the book A History of Graphic

Design created by the artist Man Ray depicts only the "roundel" design with the wording "KEEPS LONDON GOING" along the bottom of the poster. A poster depicted in Modernism shows only the "roundel" design and the word "Underground." These posters may promote the railway, but there is no reference to "London Underground" on either poster and no association of that mark with the railway.

Opposer's evidence of media attention in the United States is of minimal value. The nine newspaper articles introduced by opposer, even if they are representative of a greater number, are of little probative value in showing wide exposure of the mark. First, we cannot even determine where three of the newspapers are located or what geographic areas they serve. In addition, there is no evidence that any of these newspapers are nationally or at least widely circulated. In fact, they all appear to be local newspapers with very limited circulation and we cannot infer that this limited exposure significantly increased awareness of the mark in the United States. Although Mr. Ellis states that this is "a very small selection" of articles, he has failed to provide any context for that statement.

Finally, Mr. Ellis' conclusory assertion that "the London Underground" has appeared as a backdrop in "many, many, many" films released in the United States is entitled to little weight. There is no testimony as to when the two films mentioned by Mr.

Ellis, and the unidentified "many" others, were released, or how wide an audience they reached. Moreover, without evidence of the manner in which the mark LONDON UNDERGROUND is depicted in these films, if at all, we can draw no conclusions about its impact on viewers.²²

Opposer's evidence of purported fame of the mark in the United States suffers from the same deficiencies as its evidence of use of the mark in the United States. We cannot find that the mark is famous based on what are essentially conclusory and unsupported assertions by opposer's witness that the mark is famous.²³ As our primary reviewing court, the Federal Circuit, stated in *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (in connection with the du Pont factor of fame):

²² We note that opposer also introduced printouts of pages dated February 24, 2005 from the eBay auction website showing postings of various "London Underground" products for sale. This evidence was introduced by opposer's counsel during the cross-examination of applicant's witness, John Koo, to show an asserted "actual confusion" between the parties' goods and/or services. The postings include products identified by Mr. Koo as applicant's LONDON UNDERGROUND shoes, as well as products which, as argued by opposer, are "genuine" LONDON UNDERGROUND products from opposer. To whatever extent opposer is relying on this evidence to support its claim that the mark is famous, the evidence can be given no consideration because it is dated after the June 24, 1996 filing date of the application.

²³ Opposer also points to its "successful opposition" in the New Zealand Trademark Office "to B&G's application to register LONDON UNDERGROUND for men's and women's apparel and footwear" and a statement in the decision that opposer's LONDON UNDERGROUND mark "may be considered to be an icon." Actually, when read in context, the New Zealand Trademark Office found the mark to be an icon "in New Zealand," but, regardless, this finding in a foreign venue is not persuasive evidence of how the term is perceived in the United States.

That the fame factor is based on underlying factfinding dictates that relevant evidence must be submitted in support of a request for treatment under the fame factor. This responsibility to create a factual record is heightened under the more deferential standard that this court must apply when reviewing PTO factfinding. See *Zurko*, 527 U.S. at 165, 50 USPQ2d at 1937; *Gartside*, 203 F.3d at 1315, 53 USPQ2d at 1775. This is because judicial review under the substantial evidence standard, see *Gartside*, 203 F.3d at 1314, can only take place when the agency explains its decisions with precision, including the underlying factfindings and the agency's rationale. This necessarily requires that facts be submitted to the agency to create the record on which the agency bases its decision.

We can only draw reasonable inferences from the evidence. The layers of assumptions and inferences opposer expects us to draw from its evidence are simply not justified. We find that opposer has not established that LONDON UNDERGROUND is famous even "within the meaning of Vaudable," let alone under any higher standard of review.

Inasmuch as we find that opposer has not established priority based on either use in commerce or under the famous mark doctrine, opposer cannot prevail on the likelihood of confusion claim.

Under the circumstances, and because it is unnecessary to determine whether applicant's proposed restriction to its application would affect the issue of likelihood of confusion, the amendment is accepted, and the application will be amended in

accordance with applicant's request to delete all goods and services except "shoes and other footwear."²⁴

Decision: The opposition is dismissed.

²⁴ In permitting this amendment, we note that there is no issue as to fraud in this case nor any question raised by opposer as to applicant's bona fide intention to use the mark on all of the identified goods when the application was filed. Cf. *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003).